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09/783,897	02/15/2001	John F. Morar	YOR920000719US1	4043

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,897

Applicant(s)

MORAR ET AL.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-31 are presented for examination.

Specification

The abstract of the disclosure is objected to because the Applicant utilizes consecutive lettering indicating steps to applicant's invention; however, the alphabetical lettering is not successive. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant claims that an offer and acceptance takes place between first and second party creating a binding electronic transaction, yet a third party has the opportunity to provide the goods or services for a price either less than or greater than the contracting parties. This renders the claim indefinite because once the parties have bound themselves by acceptance of an offer, a binding electronic contract has occurred. Therefore, a third party cannot provide a counteroffer after a "meeting of the minds" that could invalidate or override the aforementioned electronic transaction.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 26-29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al., U.S. Patent 5,740,355 and Talati et al., U.S. Patent 5,903,878.

As per claim 1, '355 and '878 disclose a method for operating a data communication system, comprising steps of: originating an electronic commerce transaction at a first party; transmitting the electronic commerce transaction through the data communications network towards a second party; during the step of transmitting, inputting the electronic commerce transaction to an electronic commerce transaction filter that is interposed between two network components; and operating the electronic commerce transaction filter to take some action with respect to the electronic commerce transaction ('355: column 1-3 and figures 1-10; '878: column 2, line 50-column 3, line 60 and figures 1-10 and associated text).

As per claim 26, '355 and '878 disclose a data communication system, comprising: a first party for originating an electronic commerce transaction and for transmitting the electronic commerce transaction through a data communications network towards a second party; and an electronic commerce transaction filter that is transparently interposed between two data communication network components, said filter operating on the electronic commerce transaction in accordance with at least one filter criterion for taking some action with respect to the electronic commerce transaction ('355: column 1-3 and figures 1-10; '878: column 2, line 50-column 3, line 60 and figures 1-10 and associated text).

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As per claim 27, '355 and '878 disclose a method of conducting business over the Internet, wherein parties interact by originating an electronic commerce transaction at a first party and transmitting the electronic commerce transaction through the Internet to a second party, the method comprising steps of: intercepting the electronic commerce transaction with an electronic commerce transaction filter that is interposed between two data communication network components; and operating the electronic commerce transaction filter in accordance with at least one filter criterion so as to record at least one predetermined type of information, and further comprising steps of accumulating recorded information from a plurality of electronic commerce transactions, and making the accumulated recorded information available to interested parties ('355: column 1-3 and figures 1-10; '878: column 2, line 50-column 3, line 60 and figures 1-10 and associated text).

As per claim 28, '355 and '878 disclose a method of conducting business over the Internet, wherein parties interact by originating an electronic commerce transaction at a first party and transmitting the electronic commerce transaction through the Internet to a second party, the method comprising steps of: intercepting the electronic commerce transaction with an electronic commerce transaction filter that is interposed between two data communication network components; and operating the electronic commerce transaction filter in accordance with at least one filter criterion to record at least one predetermined type of information, and further comprising steps of accumulating recorded information from a plurality of electronic commerce transactions, deriving a new or a modified filtering criterion from the accumulated recorded information, and further comprising a step of offering the new or modified filtering

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criterion for use by another electronic commerce transaction filter ('355: column 1-3 and figures 1-10; '878: column 2, line 50-column 3, line 60 and figures 1-10 and associated text).

As per claim 29, '878 discloses a method of conducting business over the Internet, wherein parties interact by originating an electronic commerce transaction at a first party and transmitting the electronic commerce transaction through the Internet to a second party, where the electronic commerce transaction comprises an acceptance of an offer to provide goods or services based on stipulated terms; the method comprising steps of: intercepting the electronic commerce transaction with an electronic commerce transaction filter that is interposed between two data communication network components; redirecting the intercepted electronic commerce transaction to a third party; and providing the third party the opportunity to provide the goods or services for the stipulated terms or for other terms related to the stipulated terms (column 2, line 50-column 3, line 60 and figures 1-10 and associated text).

As per claim 31, '355 and '878 disclose a computer-readable medium comprising computer program instructions for directing a computer to execute a method having steps of, in response to originating an electronic commerce transaction at a first party and transmitting the electronic commerce transaction through a data communications network towards a second party, inputting the electronic commerce transaction to an electronic commerce transaction filter that is transparently interposed between two network components; and operating the electronic commerce transaction filter to take some action with respect to the electronic commerce transaction in accordance with at least one filter criterion ('355: column 1-3 and figures 1-10 and associated text; '878: column 2, line 50-column 3, line 60 and figures 1-10 and associated text).

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Claims 1-10, 13-14, 16-21, 24, 26-29, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Noll, et al., US 2002/0054087 A1.

As per claim 1, 26-29, and 31, Noll et al. discloses a method for operating a data communication system, comprising steps of: originating an electronic commerce transaction at a first party; transmitting the electronic commerce transaction through the data communications network towards a second party; during the step of transmitting, inputting the electronic commerce transaction to an electronic commerce transaction filter that is interposed between two network components; and operating the electronic commerce transaction filter to take some action with respect to the electronic commerce transaction (figures 6 and 21 with associated text; paragraphs [0100-0101]).

As per claim 2, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is an analysis of the electronic commerce transaction for the purpose of collecting information across an administrative domain (paragraphs [0007] and [0100]).

As per claim 3, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is an analysis of the electronic commerce transaction for the purpose of enforcing a policy for an administrative domain (paragraph [0061]; figure 5 and associated text).

As per claim 4, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is a modification of the electronic commerce transaction (paragraphs [0061-0062]; figure 14 and associated text).

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As per claim 5, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is a redirection of the electronic commerce transaction to a third party (paragraph [0100]).

As per claim 6, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is an extraction of information from the e-commerce transaction for recording the information for statistical or other purposes (paragraphs [0100-0101]).

As per claim 7, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is a verification of the authenticity of the electronic commerce transaction (paragraphs [0096], [0109]).

As per claim 8, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is a verification of the authenticity of a component part of the electronic commerce transaction (figures 16 and 17 with associated text).

As per claim 9, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is a verification that the electronic commerce transaction is in compliance with a regulation (paragraphs [0061-0062]).

As per claim 10, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is a verification that the electronic commerce transaction is in compliance with a standard (paragraphs [0061-0062]).

As per claim 13, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is an encryption of all or a part of the

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electronic commerce transaction, and sending the encrypted electronic commerce transaction to another destination ([paragraph [0096]]).

As per claim 14, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is generating an alert if an analysis performed by the electronic commerce transaction filter indicates that a certain filtering criterion is met (paragraph [0085]).

As per claim 16, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is selected at least in part by applying predefined rules to the contents of one or more messages that comprise the electronic commerce transaction (paragraphs [0061-0062]).

As per claim 17, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is selected at least in part by applying predefined rules that are independent of the contents of one or more messages that comprise the electronic commerce transaction (paragraphs [0061-0062]).

As per claim 18, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is selected at least in part by applying predefined rules based on at least one of an origin or a destination of the electronic commerce transaction (paragraph [0090]).

As per claim 19, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is recording at least one predetermined type of information, and further comprising steps of accumulating recorded information from a

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plurality of electronic commerce transactions, and making the accumulated recorded information available to interested parties (paragraphs [0100-0102]).

As per claim 20, Noll et al. discloses a method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is recording at least one predetermined type of information, and further comprising steps of accumulating recorded information from a plurality of electronic commerce transactions, and deriving a filtering criterion from the accumulated recorded information for use in the same or in another electronic commerce transaction filter (paragraphs [0100-0103]).

As per claim 21, Noll et al. discloses a method as in claim 1, wherein the step of operating is performed in parallel in a plurality of electronic commerce transaction filters that are disposed between two layers of an administrative domain hierarchy (paragraphs [0100-0101]).

As per claim 24, Noll et al. discloses method as in claim 1, wherein the action taken with respect to the electronic commerce transaction is a verification that the electronic commerce transaction is in compliance with a predetermined policy (paragraphs [0095-0098]).

Claims 1, and 26-30 are further rejected under 35 U.S.C. 102(e) as being anticipated by Rodriguez, et al., US 2002/0049804 A1.

As per claim 1, Rodriguez et al. discloses a method for operating a data communication system, comprising steps of: originating an electronic commerce transaction at a first party; transmitting the electronic commerce transaction through the data communications network towards a second party; during the step of transmitting, inputting the electronic commerce transaction to an electronic commerce transaction filter that is interposed between two network

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components; and operating the electronic commerce transaction filter to take some action with respect to the electronic commerce transaction (figures 1-3 and associated text).

As per claim 26, Rodriguez et al. discloses a data communication system, comprising: a first party for originating an electronic commerce transaction and for transmitting the electronic commerce transaction through a data communications network towards a second party; and an electronic commerce transaction filter that is transparently interposed between two data communication network components, said filter operating on the electronic commerce transaction in accordance with at least one filter criterion for taking some action with respect to the electronic commerce transaction (figures 1-3 and associated text).

As per claim 27, Rodriguez et al. discloses a method of conducting business over the Internet, wherein parties interact by originating an electronic commerce transaction at a first party and transmitting the electronic commerce transaction through the Internet to a second party, the method comprising steps of: intercepting the electronic commerce transaction with an electronic commerce transaction filter that is interposed between two data communication network components; and operating the electronic commerce transaction filter in accordance with at least one filter criterion so as to record at least one predetermined type of information, and further comprising steps of accumulating recorded information from a plurality of electronic commerce transactions, and making the accumulated recorded information available to interested parties (figures 1-3 and associated text).

As per claim 28, Rodriguez et al. discloses a method of conducting business over the Internet, wherein parties interact by originating an electronic commerce transaction at a first party and transmitting the electronic commerce transaction through the Internet to a second

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party, the method comprising steps of: intercepting the electronic commerce transaction with an electronic commerce transaction filter that is interposed between two data communication network components; and operating the electronic commerce transaction filter in accordance with at least one filter criterion to record at least one predetermined type of information, and further comprising steps of accumulating recorded information from a plurality of electronic commerce transactions, deriving a new or a modified filtering criterion from the accumulated recorded information, and further comprising a step of offering the new or modified filtering criterion for use by another electronic commerce transaction filter (figures 1-3 and associated text).

As per claims 29 and 30, Rodriguez et al. discloses a method of conducting business over the Internet, wherein parties interact by originating an electronic commerce transaction at a first party and transmitting the electronic commerce transaction through the Internet to a second party, where the electronic commerce transaction comprises an acceptance of an offer to provide goods or services based on stipulated terms; the method comprising steps of: intercepting the electronic commerce transaction with an electronic commerce transaction filter that is interposed between two data communication network components; redirecting the intercepted electronic commerce transaction to a third party; and providing the third party the opportunity to provide the goods or services for the stipulated terms or for other terms related to the stipulated terms; for a price that is either less than or greater than a price set by the stipulated terms (figures 1-3 and associated text; paragraphs [0055] and [0083]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable, because it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the above referenced claim limitations.

As per claims 11, 12, and 15, the Applicant recites a variety of conditions or circumstances affecting an electronic commerce transaction, namely, termination (claim 11), delay (claim 12) or completion without modification or recording of any information during transmission (claim 15). Noll et al. does not specifically disclose these circumstances. However, the Examiner takes **Official Notice** that it is standard in electronic commerce transactions that certain conditions will either terminate or complete a transaction without any modifications or with possible delays, i.e., a time out event. Although Noll et al. does not specifically disclose these circumstances, they are common conditions that can occur in any e-commerce transaction.

Claims 22, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noll et al., in view of Robinson et al, U.S. Patent 5,915,022.

As per claims 22, 23, and 25, Noll et al. teaches a web-based e-commerce system wherein transactions are processed at the network operation center (NOC) to implement an "interception" of purchase transactions back to the NOC to record each incoming secure purchase in a transaction database (figure 17 and associated text). The e-commerce router then

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automatically securely re-routes the purchase to the originally defined destination, while at the same time tracking generated revenues and pro-active invoicing of e-commerce retailers (paragraph [0100-0101]). Noll et al. does not explicitly teach the use of an encryption/decryption mechanism as part of the electronic commerce transaction for preventing fraud or authentication. Robinson et al. teaches the use of an encryption/decryption mechanism and private-key cryptosystem for authenticating e-commerce transactions (column 2, line 25 – column 3, line 10; figures 1-2, and 5; column 4-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Noll's electronic commerce system with Robinson's encryption mechanism to further secure and authenticate transactions from unauthorized interception or fraud.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent 6,058,375 to Park.
- U.S. Patent 6,078,918 to Allen et al.
- U.S. Patent 6,029,141 to Bezos et al.
- U.S. Patent 5,442,639 to Crowder et al.
- U.S. Patent 6,249,572 B1 to Brockman et al.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested

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from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached Tuesday – Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6128 for regular communications and 703-746-6128 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

bbb
July 24, 2003



JAMES P. TRAMMELL
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TECHNOLOGY CENTER 3600